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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,625	06/26/2003	Shigeki Matsubara	KAS-183	4454

7590 09/01/2006

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EXAMINER

RAMILLANO, LORE JANET

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 09/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/603,625

Applicant(s)

MATSUBARA ET AL.

Examiner

Lore Ramillano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/26/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite because it cannot be determined whether applicant intended the following term -- "separation means" -- to be considered a structural limitation of the automatic analyzer since the "wherein" clause generally raises a question as to the limiting effect of the language, after the clause, in a claim. In addition, it cannot be determined what applicant means by reciting that the "separation means" is "for separating said analysis unit from the control of said central control device"?

Claim 2 is indefinite because it cannot be determined whether applicant is claiming a structural limitation since it contains the following functional language: "the function of turning off the power source." Is applicant claiming that the central control unit comprises a "power source"? A "power switch" to turn off the power?

Claim 3 is indefinite because it cannot be determined whether applicant is claiming a structural limitation since it contains the following functional language: "the function of again turning on the power source." Is applicant claiming that the central control unit comprises a "power source"? A "power switch" to turn on the power?

Claim 4 is indefinite because it cannot be determined whether applicant intended the following term -- "predetermined sections" -- to be considered a structural limitation

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of the automatic analyzer since the "wherein" clause generally raises a question as to the limiting effect of the language, after the clause, in a claim. In addition, it cannot be determined what applicant means by reciting "predetermined sections"? In addition, it cannot be determined whether applicant is claiming a structural limitation after the "wherein" clause since it contains the following functional language: "function for specifying any one of the predetermined sections."

Claim 5 is indefinite because it cannot be determined whether applicant is claiming a structural limitation since it contains the following functional language: "function for enabling said specifying any one of the sections displayed." What is "said specifying"?

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-5** are rejected under 35 U.S.C. 102(b) as being anticipated by Ohishi et al. ("Ohishi," US 6019945).

Ohishi discloses an automatic analyzer comprising: a conveying line for conveying a sample supplied from a sample introduction section (20, Fig. 1); at least

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one analysis unit for analyzing the sample conveyed by said conveying line (i.e. 3A, 3B, and 3C, Fig. 1); a sample storage section for storing the sample analyzed by said analysis unit (22, Fig. 1); a central control device for comprehensively controlling said sample introduction section, said conveying line, said analysis unit, and said sample storage section (column 9, lines 43-50); and a display means for displaying said sample introduction section (column 4, lines 47-50).

5. **Claims 1-5** are rejected under 35 U.S.C. 102(b) as being anticipated by Babson et al. ("Babson," US 6019945).

Babson discloses an automatic analyzer comprising: a conveying line for conveying a sample supplied from a sample introduction section (202, column 7, lines 40-59); at least one analysis unit for analyzing the sample conveyed by said conveying line (i.e. column 8, lines 30-47); a sample storage section for storing the sample analyzed by said analysis unit (column 10, lines 50-64); a central control device for comprehensively controlling said sample introduction section, said conveying line, said analysis unit, and said sample storage section (12, Fig. 1, column 10, lines 26-49); and a display means for displaying said sample introduction section (16, Fig. 1).

6. **Claims 1-5** are rejected under 35 U.S.C. 102(e) as being anticipated by Kodama et al. ("Kodama," US 6599749).

The applied reference has a common inventor (Mimura) with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this

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application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Kodama discloses an automatic analyzer comprising: a conveying line for conveying a sample supplied from a sample introduction section (13, Fig. 1); at least one analysis unit for analyzing the sample conveyed by said conveying line (i.e. 100, 200, Fig. 1); a sample storage section for storing the sample analyzed by said analysis unit (81, Fig. 1); a central control device for comprehensively controlling said sample introduction section, said conveying line, said analysis unit, and said sample storage section (1, Fig. 1); and a display means for displaying said sample introduction section (85, Fig. 1). (column 3, lines 8-27).

7. **Claims 1-5** are rejected under 35 U.S.C. 102(b) as being anticipated by Matsubara et al. ("Ref '718," US 6319718).

Ref '718 discloses an automatic analyzer comprising: a conveying line for conveying a sample supplied from a sample introduction section (60, Fig. 1); at least one analysis unit for analyzing the sample conveyed by said conveying line (i.e. 100, Fig. 1); a sample storage section for storing the sample analyzed by said analysis unit (2, Fig. 1); a central control device for comprehensively controlling said sample introduction section, said conveying line, said analysis unit, and said sample storage section (50, Fig. 1); and a display means for displaying said sample introduction section (53, Fig. 1).

8. **Claims 1-5** are rejected under 35 U.S.C. 102(e) as being anticipated by Matsubara et al. ("Ref '960," US 6752960).

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The applied reference has a common inventor (Matsubara) with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Ref '960 discloses an automatic analyzer comprising: a conveying line for conveying a sample supplied from a sample introduction section (102, Fig. 1); at least one analysis unit for analyzing the sample conveyed by said conveying line (i.e. 104, Fig. 1); a sample storage section for storing the sample analyzed by said analysis unit (i.e. 217, Fig. 2); a central control device for comprehensively controlling said sample introduction section, said conveying line, said analysis unit, and said sample storage section (312, Fig. 1); and a display means for displaying said sample introduction section (53, Fig. 1).

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-5 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6752960. Although the conflicting claims are not identical, they are not patentably distinct from each other because both recite substantially the same subject matter.

Claims 1-5 recite substantially the same subject matter as recited in the patent claims -- an automatic analyzer comprising: a conveying line (a conveying device); at least one analysis unit (first and second analysis unit); a sample storage section (sample dispenser, which uses a dispenser tip for replacement every sample); a central control device (storage unit for storing carry-over avoidance levels); and a display means (screen display device).

Therefore, claims 1-5 are fully encompassed by claims 1-2 of U.S. Patent No. 6752960.

11. Claims 1-3 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 3-5 of U.S. Patent No. 6599749. Although the conflicting claims are not identical, they are not patentably distinct from each other because both recite substantially the same subject matter.

Claims 1-3 recite substantially the same subject matter as recited in the patent claims -- an automatic analyzer comprising: a conveying line (main conveyance line); at

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least one analysis unit (plurality of analysis units); a sample storage section (rack housing device); and a central control device (controller).

Therefore, claims 1-3 are fully encompassed by claims 3-5 of U.S. Patent No. 6599749.

12. Claims 1-5 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 11/390104. Although the conflicting claims are not identical, they are not patentably distinct from each other because both recite substantially the same subject matter.

Claims 1-5 recite substantially the same subject matter as recited in the copending application because both encompass an automatic analyzer comprising: a conveying line (rack transporting apparatus); at least one analysis unit (first analysis unit); a sample storage section (rack introducing unit); a central control device (control unit); and a display means (display unit).

Therefore, claims 1-5 are fully encompassed by claims 1-4 of copending Application No. 11/390104.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lore Ramillano whose telephone number is (571) 272-7420. The examiner can normally be reached on Mon. to Fri.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lore Ramillano
Examiner
Art Unit 1743

8/24/06


Jill Warden
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